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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/049,147 04/19/93 GINOFSKY

EXAMINER  
L 604107/207

ART UNIT PAPER NUMBER  
5 5

33M170916

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DATE MAILED:  
3309

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

09/16/93

This application has been examined  Responsive to communication filed on July 21, 1993  This action is made final.

A shortened statutory period for response to this action is set to expire — 3 — month(s), — 3 — days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- Notice of References Cited by Examiner, PTO-892.
- Notice of Draftsman's Patent Drawing Review, PTO-948.
- Notice of Art Cited by Applicant, PTO-1449.
- Notice of Informal Patent Application, PTO-152.
- Information on How to Effect Drawing Changes, PTO-1474.
- \_\_\_\_\_

Part II SUMMARY OF ACTION

- 44-56
1.  Claims \_\_\_\_\_ are pending in the application.
  2.  Claims 1-43 have been cancelled.
  3.  Claims \_\_\_\_\_ are allowed.
  4.  Claims 44-56 are rejected.
  5.  Claims \_\_\_\_\_ are objected to.
  6.  Claims \_\_\_\_\_ are subject to restriction or election requirement.
  7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
  8.  Formal drawings are required in response to this Office action.
  9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable;  not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
  10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been  approved by the examiner;  disapproved by the examiner (see explanation).
  11.  The proposed drawing correction, filed \_\_\_\_\_, has been  approved;  disapproved (see explanation).
  12.  Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
  13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
  14.  Other

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The numbering of claims is not accordance with 37 C.F.R. § 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 C.F.R. § 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 71-83 have been renumbered 44-56, respectively.

Claims 44-56 of this application has been copied by the applicant from United States Patent Nos. 5,037,421 and 5,147,354. This claim is not patentable to the applicant because Applicant's original disclosure does not require that the tissue be irrigated while ablation occurs nor that the tissue be maintained in a fluid field.

An interference cannot be initiated since a prerequisite for interference under 37 C.F.R. § 1.606 is that the claim be patentable to the applicant subject to a judgement in the interference.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains,

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or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately teach how to make and use the invention, i.e., failing to provide an enabling disclosure and because Applicant's disclosure, as originally filed, does not provide support for the device as now claimed.

The disclosure does not discuss the specific claim limitations above.

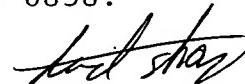
Claims 44-56 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 44-56 of this application is asserted by applicant to correspond to claims of U.S. patent nos. 5,037,421 and 5,147,354.

The examiner does not consider this claim to be directed to the same invention as that of U.S. Patent Nos. 5,037,421 and 5,147,354 because Applicant's claims cover a wavelength range unsupported by the patent disclosures. Accordingly, an interference cannot be initiated based upon this claim.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-0858.

D. Shay/dh  
September 07, 1993

  
DAVID M. SHAY  
PRIMARY EXAMINER  
GROUP 330